

PATENT
Docket No. 212302000320**COPY**

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

Express Mail Label No.: EL569176266US

Date of Deposit: August 21, 2000

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.


Debra J. Glaister

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Stefan MILTENYI et al.

Serial No.: 08/416,920

Filing Date: April 21, 1995

For: DIRECT SELECTION OF CELLS BY
SECRETION PRODUCT

Examiner: R. Schwadron

Group Art Unit: 1644

FAX RECEIVED

AUG 23 2001

PETITIONS OFFICE

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNINTENTIONALLY UNDER 37 C.F.R. § 1.137(b) AND PETITION TO WAIVE
RULES UNDER 37 C.F.R. § 1.183**

Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicants petition for revival of the above-referenced application under
37 C.F.R. § 1.137(b).

The above-identified application has not been deemed abandoned by the USPTO. Upon review of the file history, it was discovered that the above-identified application may have been abandoned due to an amendment mailed June 10, 1998, characterized by the Examiner as non-responsive.

The USPTO issued a communication to Applicants dated September 2, 1998, which stated that Applicants' reply filed on June 12, 1998, was not fully responsive to the prior Office

COPY

Action dated December 9, 1997, due to "amendments to the claims that were not the claims under consideration prior to submission of the amendment filed 6/12/98". Applicants responded with a Supplemental Amendment to the claims transmitted via facsimile on September 16, 1998. In the Office Action dated June 20, 1999, paper number 19, the Examiner appears to consider and enter the Supplemental Amendment sent on September 16, 1998, but states that the amendment to claim 20 still needs to be corrected.

At this point, the USPTO did not consider the status of the application as abandoned due to the alleged problem with claim 20. Applicants are concerned that the Supplemental Amendment sent September 16, 1998, was technically non-responsive to the Office Action mailed December 9, 1997, and are concerned that the application was technically abandoned at that point.

Applicants discussed the question of abandonment of the instant application in a telephone conference with Brian Hearn in the Office of Petitions. In that telephone conversation, it was concluded that there was a possibility that the instant application was technically abandoned and that this was not recognized by the USPTO.

In an abundance of caution, Applicants are submitting the instant Petition to Revive under 37 C.F.R. 1.137(b). Pursuant to 1.137(b)(1), it is submitted that the required reply to the Office Action dated December 9, 1997 was filed June 12, 1998 with a Supplemental Amendment filed September 16, 1998 and Applicants are submitting concurrently herewith a request for further examination pursuant to 37 C.F.R. 1.129(a); pursuant to 1.137(b)(2) the appropriate fee is being submitted; and pursuant to 1.137(b)(3), Applicants submit that the entire delay until the filing of a grantable petition under 1.137(b) was unintentional.

37 C.F.R. 1.137(b)(4) requires the filing of a terminal disclaimer pursuant to 1.137(c), along with the appropriate fee. If the USPTO finds that the application was technically abandoned due to the response filed June 12, 1998, Applicants Petition the Commissioner under 37 C.F.R. 1.183 to waive the 1.137(b)(4) requirement for a terminal disclaimer as provided by M.P.E.P. 711.03(c) III G. Applicants submit that the requirement for a terminal disclaimer appears inappropriate under the present circumstances where a USPTO examiner did not recognize a situation of abandonment and Applicants were never mailed a Notice of Abandonment. Applicants request waiver of this requirement *in toto*. In the alternative, Applicants petition the Commissioner to waive the rules regarding the time period to be

COPY

dedicated to the public for the terminal part of the term of any patent granted. If the USPTO finds that the application was technically abandoned due to the response filed June 12, 1998, Applicants believe that it would be inappropriate to require dedicating the approximately two and one-half year abandonment period to the public since the status of abandonment was never recognized by the USPTO. In a further alternative, if the USPTO finds that the application was technically abandoned and denies the Petition to the Commissioner under 37 C.F.R. 1.183 to waive the 1.137(b)(4) requirement, Applicants request a further time period to provide a terminal disclaimer pursuant to 37 C.F.R. 1.37(b)(4).

If the USPTO finds that the Petition to Revive under 37 C.F.R. 1.137(b) is deemed unnecessary, it is requested that any fees associated with said Petition, or the Petition under 37 C.F.R. 1.183, be credited to the Deposit Account No. identified below.

- ☒ A verified small entity statement was previously filed in this application.
- ☒ Please charge \$605.00 for the Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b) and/or \$130.00 for the Petition to Waive Rules Under 37 C.F.R. § 1.183 if deemed necessary to Deposit Account No. 03-1952 referencing docket no. 212302000320.

The Assistant Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. §§ 1.16 and 1.17 that may be required by this petition, or to credit any overpayment, to Deposit Account No. 03-1952. A duplicate copy of this petition is enclosed for that purpose.

COPY

- ☒ I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Respectfully submitted,

Dated: August 21, 2000

By: Debra J. Glaister
Registration No. 33,888Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018
Telephone: (650) 813-5725
Facsimile: (650) 494-0792